

The Patents Act, 1970

Section 15

In the matter of the Patents Act, 1970

as amended by the Patents (Amendment) Act, 2005

In the matter of the Patents Rules, 2003

as amended by the Patents (Amendment) Rules,
2016

And

In the matter of an application for

Patent no.2440/DELNP/2006 filed on

01/05/2006

DECISION

Introduction

1. The instant application titled "PROTECTED DYNAMIC PROVISIONING OF CREDENTIALS" was filed on May 01, 2006 claiming priority of USA 10/702,167 dated November 05, 2003 through its agent Evalueserve.com Pvt Ltd.
2. Request for examination was made on October 18, 2006. Case was examined and report was prepared u/s 12 and 13 of Indian Patent Act-1970 (as amended). Since the report was adverse, gist of objections (herein after first examination report) were communicated as expeditiously as possible by the controller dated July 29, 2010 to the applicant's address for service on record.
3. After the issuance of FER, Form-13 was filed on June 22, 2011 to incorporate the change in address for service as applicant has transferred the responsibility to prosecute the matter to Mr. Dinesh Jotwani of M/s Aggarwal Associates from Evalueserve.com Pvt Ltd.
4. A petition u/r 137 was filed by the applicant dated September 14, 2011 through patent Agent, Mr. Dinesh Jotwani for condonation of delay in

filing the response of examination report read with section 81 of the Patent Act, 1970 within stipulated time i.e. 12 months from the date of issuance of first examination report. Response to first objection report was filed on September 26, 2011.

5. Further Form -13 was filed on February 04, 2015 to incorporate the change in address for service as applicant has once again transferred the responsibility to prosecute the matter to M/s K & S Partners from Mr. Dinesh Jotwani of M/s Aggarwal Associates.
6. Since the last date to put the application for grant was over on July 30, 2011 and official requirements were not complied. Therefore before taking any adverse decision, for the sake of natural justice hearing was offered and hearing notice was communicated to concerned Patent Agent M/s K & S Partners and date of hearing was fixed on 23/06/2016. During hearing, it was observed that a petition u/r 137 was filed by the erstwhile Agent, Mr. Dinesh Jotwani for condonation of delay in filing the response of examination report read with section 81 of the Patent Act, 1970.. In view of that a fresh hearing was offered on July 07, 2016 (actually held on July 08, 2016 as July 07, 2016 was holiday) to decide the facts/reasons which are beyond the controller of applicant to refile the documents within stipulated time. It was also communicated to applicant's agent that instant application would proceed further only if petition u/r 137 was allowed.

Relevant Provisions Under The Law

7. **Section 21(1)** says " An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller."

Explanation.-Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

8. **Rule 137 says** " Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct."
9. **Rule 138 says** " Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rule (10) and (11) of rule 24C, sub-rule 4 of rule 55, sub-rule (1A) of rule 80 and sub-rule (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct." Any request for extension of the time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules.
10. **Chapter 8.04 of Manual of Patent Office Practice and Procedure** says "If for reasons beyond the control of the applicant, the applicant re-files the documents after twelve months from the date of issuance of FER, the Controller may decide to proceed with the case based on the evidence made available to him for such delay."

Analysis

Following analysis is made after considering the written submissions as filed in pursuance of the hearing dated July 7, 2016 and petition u/r 137

dated September 14, 2011 for condonation of delay in filing the response of examination report and relevant provisions under the Act:

11. The argument that applicants were not informed about the issuance of first examination report is not sustainable on the basis of:

a. Status of every patent application is freely available on patent office website i.e. www.ipindia.nic.in.

b. At the time of filing of Form-13 dated June 22, 2011, more than one month time was available to the applicants to meet the official requirements.

12. It is further submitted that petition u/r 137 was filed on September 14, 2011 for condonation of delay in filing the response of examination report whereas response to first objection report was not filed along with the petition. The same was filed on September 26, 2011 delayed by further 12 days. This clearly shows negligence in part of erstwhile patent agent. It is hard to believe that delay caused was unintentional. The term "unintentional" means where the agent of the applicant/applicant itself was not aware about the issuance of first examination report and the deadline to comply with the requirements as raised in first examination report. It has to be noted that the agent of applicant was fully aware of the deadline, and was not vigilant and lapsed the deadline as prescribed by the Act. It is negligence not only at the part of erstwhile patent agents but also at the part of applicant as well. If it is to be considered that it was the duty of previous agents M/s Evalueserve.com Pvt. Ltd. to transfer all the previous proceedings to another authorised patent agent Mr. Dinesh Jotwani of M/s Aggarwal Associates for processing instant patent application then applicant is also duty bound to insure for smooth transfer of all related proceedings from one patent agent to other patent agent. Applicant's arguments in petition u/r 137 to take on record the response to first examination report after prescribed time frame under Section 81 is not allowable as there is no such provision mentioned in the section.

13. The ruling of Hon'ble Supreme Court of India in the matter of Kailash

vs. Nanhku and Ors.; (2005) 4SCC480, as quoted by the agent of applicant in his submission dated July 22, 2016, clearly mentioned that –“.... the provisions of the CPC or any other procedural enactment ought not to be construed in a manner which would leave the court helpless to meet extraordinary situations in the ends of justice.....”. However the facts and circumstance of the instant case are clearly distinguished from that ruling. The present situation nowhere meets the category of extraordinary situation as envisaged by the Hon’ble Supreme Court.

14. The Hon’ble High Court order as quoted by the agent in the matter of NTT DoCoMo Inc., vs. The Assistant Controller of Patents and Designs; W.P.No.6594 of 2013 is evidently different from instant case. In the matter as quoted by the Applicant, patent application was wrongly withdrawn because agent of applicant furnished wrong application number in his request for withdrawal. Whereas in instant case, patent agent, duly authorised by the applicant on Form-26 filed on May 01, 2006, was fully aware that first examination report was duly communicated to him.
15. The Hon’ble Supreme Court order as quoted by the Applicant in the matter of Sardar Amarjit Singh Kalravs. Pramod Gupta, (2003) 3 SCC 272, held as under:- “26. Laws of procedure are meant to regulate effectively, assist and aid the object of doing substantial and real justice and not to foreclose even an adjudication on merits of substantial rights of citizen under personal, property and other laws. Procedure has always been viewed as the handmaid of justice and not meant to hamper the cause of justice or sanctify miscarriage of justice.....”. Further, the Hon’ble Supreme Court in the matter of State Of Haryana vs Chandra Mani & Ors; 1996 SCC (3) 132 as quoted by the applicant; held that: “The expression ‘sufficient cause’ is adequately elastic to enable the court to apply the law in a meaningful manner which sub serves the ends of the justice-that being the life-purpose for the existence of the institution of courts. It is common knowledge that this Court has been making a justifiably liberal approach in matters

instituted in this Court.When substantial justice and technical considerations are pitted against each other, cause of substantial justice deserves to be preferred for the other side cannot claim to have vested right in injustice being done because of a non-deliberate delay. There is no presumption that delay is occasioned deliberately, or on account of culpable negligence, or on account of mala fides. A litigant does not stand to benefit by resorting to delay. In fact he runs a serious risk. Judiciary is not respected on account of its power to legalize injustice on technical grounds but because it is capable of removing injustice and is expected to do so.” . Whereas in case of *Kailash v. Nanhku* (2005) 4 SCC 480, the Hon'ble Supreme Court has also held that " A prayer for extension of time made by the defendant shall not be granted just as a matter of routine and merely for asking.....extension of time may be allowed if it was needed to be given for the circumstances which are exceptional, occasioned by reasons beyond the control of the defendant.....” .

16.I also want to quote a decision of Hon'ble High Court of Delhi in *NIPPON STEEL CORPORATION vs UNION OF INDIA* (W.P. (C) 801 of 2011). In their decision dated 8th February 2011 Hon'ble High Court of Delhi held that "there is a logic to the time limits set out under the Act. The scheme of the Act and the Rules require time-bound steps to be taken by applicants for grant of patent at various stages. The provisions of the Act and the Rules have to expressly reflect the legislative intent to permit relaxation of time limits, absent which such relaxation cannot be 'read into' the provisions by a High Court exercising powers under Article 226 of the Constitution. In other words, it is not possible for this Court to accept that the time-limits under..... the Act read with Rules are merely “directory” and not mandatory." In the decisions in *R.N. Jadi & Brothers v. Subhashchandra* (2007) 6 SCC 420 and *Mohammed Yusuf v. Faij Mohammad* (2009) 3 SCC 513, Hon'ble Supreme Court has further clarified this position." The time limits as prescribed either in the Act or in the rules are statutory and therefore mandatory in nature not merely in directory nature.

17. It is also very pertinent to highlight that it is the applicant who enjoys all the rights of the granted patent. Therefore it is the duty of applicant to take cognizance of all the proceedings of patent application from patent agents. Patent rights are monopoly rights. It debars other to make, use, sell etc. without his consent. The Applicant as well as the agent of the applicant should have to be more vigilant while dealing with patent application through their patent agent especially for meeting out all the statute requirements within prescribed time frame.

Conclusion

18. Having considered the petition filed under rule 137 for condonation of delay in filing response to examination beyond the statutory period as prescribed under the Patent Act, 1970 and Patent Rules, 2016 and arguments during hearing submitted by the agent for the applicant and facts on the record and also in view of my findings and reasons as mentioned above, I am of the opinion that the petition filed under rule 137 is not allowable since all possible reasons as mentioned by the applicant's agent such as lack of knowledge about the issuance of examination report or lapse on the part of the previous agent in providing true facts/ First Examination Report, are not the reasons sufficient enough to qualify the status of "beyond the control of applicant" as mentioned in section 21(1) of the Act. Therefore response to examination of instant application cannot be taken on record for further processing since the application has become deemed abandoned under section 21(1) IPA-1970 (as amended) as applicant has not refilled the documents within stipulated time period i.e. within 12 months from the date of issuance of first examination report.

Dated March 27, 2017

(Vijay Singh)

Asst. Controller of Patents & Designs

Copy to: M/s K & S Partners

